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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,920	04/12/2004	Karl Pays	05725.1347-00000	2432
Thomas L. Irving FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
09/03/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,920

Applicant(s)

PAYS ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of amendment and remarks filed on 5/29/08. Claims 10-11 have been canceled as per applicants' amendment dated 5/29/08. Claims 1, 2, 5, 8, 9, 12, 18, 19, 21-24, 26, 36, 40, and 45 are examined in the application. Claims 71, 73, 77, 79, 82, and 83 were withdrawn from consideration as being drawn to non-elected subject matter.

Claim Rejections - 35 USC § 103

1. Claims 1, 2, 5, 8-12, 18-19, 21-24, 26, 36, 40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105(105) and 5,866,111 ('111).

Instant application is claiming a cosmetic composition comprising:

Polystearyl acrylate

Sulfoester as the film forming polymer in a cosmetically acceptable medium

Dyestuff (claim 36).

Patent '105 teaches cosmetic make up compositions using polystearyl acrylate. This compound is the species of formula II. See the abstract, see col.1, ll 5-46, see col.2, ll 1-46, see col.3, ll 65-66, see col.4, ll 49-65 for dyestuff, see col.4 last paragraph for solvents. These solvents belong to cosmetically acceptable medium. See also col.5, ll 9-64 for various cosmetic products. See examples and see claims 1-12 and see especially claim 5 for polystearyl acrylate. Patent '105 does not teach the film forming polymer sulfoester. However, patent '111 teaches claimed sulfoester as the film forming 'polymer and using this film former in cosmetic compositions. See the abstract, see col.3, line 37 through col.4 line 43. See col.4, line 25 for EASTMAN AQ polymers. Sulfoester is also EASTMAN AQ polymer. See col.5, ll 19-26 and

see the examples. Both the compositions taught by patent are drawn to mascara compositions (cosmetic).

Accordingly it would be obvious to one skilled in the cosmetic art to prepare a third composition by combining the prior art ingredients. One of ordinary skill in the cosmetic art would combine the polystearyl acrylate and dyestuff of patent '105 and combine it with the film forming polymer since the third composition which has polystearyl acrylate when used in the form of mascara has good adherence and have sufficient brilliance and when polystearyl acrylate is combined with film forming polymer of patent '111, the composition in the form of mascara has the properties of eyelash elongation, eyelash curving which are beneficial to the consumer. Combining the prior art ingredients in the field of endeavor prompt variations of it for use in the same field of endeavor. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 5/29/08 have been fully considered but they are not persuasive.

Applicants' argue:

"The '105 patent discloses "[a] fatty composition for use in producing cosmetic composition[s] comprising a mixture of at least one cosmetic fatty body and at least one non-toxic polymer." '105 patent, Abstract. However, the '105 patent fails to disclose or suggest Applicants' claimed invention, at least because the '105 patent does not disclose the use of polystearyl acrylate, contrary to the Examiner's assertions. Example 8 of the '105 patent contains polystearyl methacrylate, and Example 9 contains "polystearyl methacrylate cross-linked with

0.02% ethylene glycol dimethacrylate." Claim 5 recites polystearyl acrylate, but there is no reference or citation of polystearyl acrylate in the specification of the '105 patent, or in any of claims 1-4 and 6-12. Moreover, polystearyl methacrylate is not disclosed in any of the claims of the '105 patent. Thus, it appears that claim 5 of the '105 patent should disclose polystearyl methacrylate instead of polystearyl acrylate. In addition, the '105 patent fails to disclose or suggest, any desired thermal profile or melting peak, and certainly not "[a] cosmetic composition comprising ... at least one first compound which gives the cosmetic composition a thermal profile wherein the melting peak has a mid-height width L_f less than or equal to 10°C , wherein the at least one first compound has a thermal profile wherein the melting peak has a mid-height width L_f less than or equal to 10°C ," as recited in amended independent claim 1".

In response to the above argument, claim 5 of the patent claims "polystearyl acrylate" and claim 1 recites both the acrylate esters and methacrylate esters. Applicants' attention is drawn to formula II; where in R1 can be hydrogen or methyl. Patent '105 teaches the use of the elected semi-crystalline polymers, which are copolymers, and certainly does disclose use of the claimed "at least one compound ... chosen from waxes and semi-crystalline polymers having a melting point ranging from 35°C to 65°C ," as recited in amended independent claim 1 since the elected species belonging to semi-crystalline polymer is "polystearyl acrylate". Waxes belonging to "at least one compound" is drawn to non-elected subject matter. PTO is not equipped to determine the claimed desired thermal profile or melting peak, and claimed cosmetic composition comprising ... at least one compound which gives the cosmetic composition a

thermal profile having a melting peak wherein the mid-height width L_f is less than or equal to 10°C " since the thermal profile is determined by heating an empty crucible and a crucible containing a sample of said composition and measuring the variation of the difference in power absorbed by the empty crucible and by the crucible containing the sample as a function of temperature.

Applicants' also argue:

"The Examiner cites the '111 patent in an attempt to overcome the deficiencies of the '105 patent. The Examiner asserts that the '111 patent "teaches claimed sulfoester as the film forming 'polymer and using this film former in cosmetic compositions." Office Action at 4. Nevertheless, without acceding to the Examiner's allegations, Applicants submit that the '111 patent does not cure all of the deficiencies of the '105 patent discussed above with respect to amended independent claim 1. Further, neither the '105 patent nor the '111 patent teach or suggest a composition wherein "the at least one amorphous film-forming polymer is present in an amount greater than or equal to the amount of the at least one first compound." See claim 1. Moreover, neither reference separately nor combined provide motivation to arrive at a composition as presently claimed. Therefore, the teachings of the '105 and '111 patents, separately, or even if combined as the Examiner suggested, do not render obvious Applicants' invention, as recited in amended independent claim 1".

In response to the above argument, both the patents teach the individually components in cosmetic compositions and both the components are used in mascara compositions. Patent '105

under examples 26-30 teaches mascara compositions and patent teaches using the polymer belonging to formula I or formula II. Patent '11 clearly teaches to one skilled in the mascara art that sulfoester polymers as film forming polymers have better properties than the conventional mascara existing in the market and therefore one of ordinary skill in the cosmetic art would prepare a third compositions by combining the polystearyl acrylate and dyestuff of patent '105 and combine it with the film forming polymer of patent '111 since the third composition which has polystearyl acrylate when used in the form of mascara has good adherence and have sufficient brilliance and when polystearyl acrylate is combined with film forming polymer of patent '111, the composition in the form of mascara has the properties of eyelash elongation, eyelash curving which are beneficial to the consumer. Combining the prior art ingredients in the field of endeavor prompt variations of it for use in the same field of endeavor.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615